I.   Front Page of Office Action

The front page of the June 6, 2005 office action indicates that claims 1 and 55-87 are pending and claims 1 and 55-87 are rejected.

II.   Status of Claims

Claims 1, 55, 86, and 87 are the only independent claims.

Claims 1, 55, and 57-87 are pending and rejected.

Support for amendments to claims 55, 86, and 87 is found as follows.

Support for "collecting, during an offline purchase transaction of a first consumer <u>at a point of sale terminal in a retail store</u>, a first consumer offline purchase history data and a first customer identification for said first consumer" is found at page 15 lines 18-23, which states that:

> After starting, in step 50, the consumer's offline purchase information is
> obtained. This information is obtained in the preferred embodiment by a
> computer used to implement a sale or sales transaction to a user and may utilize a
> general purpose computer or point of sale terminal.

Support for "delivering said determined targeted advertisement to said first consumer <u>via said consumer computer</u>" is found at page 15 lines 10-11, which discloses that targeted advertisements are electronically delivered to the respective computers of registered consumers. A consumer computer, items 10 and 12 respectively in Figure 1, is defined at page 9 lines 18-19, which states that:

> The first and second computers 10, 12 may be any computer that one or
> more consumers can access, such as home or office computers.

Figure 12 is a general purpose computer and page 9 lines 12-14 discloses that computers 10 and 12 may be implemented as such a general purpose computer.

Support for "wherein said consumer computer is at least one of a computer at said first consumer's home and a computer at said first consumer's office" is found at page 9 lines 18-19, which states that:

> The first and second computers 10, 12 may be any computer that one or more consumers can access, such as home or office computers.

Support for "wherein said consumer computer is not at said point of sale terminal" is found at page 8 lines 21-22, which states that:

> The stores 2, 4, 6 may be any retail location, point of sale, or other location in which offline transactions are made by consumers.

Figure 1 shows a distinction between retail stores 2, 4, and 6 and first computer 10 and second computer 12. Therefore, it is apparent that the consumer computer is not located at a point of sale terminal at a retail store.

In further support of the distinction that a consumer computer is not at a point of sale terminal, page 1 lines 25-27 of the specification distinguishes an online purchase from a personal computer from an offline purchase at the point of sale at a "bricks and mortar store," stating that:

> For example, using a computer to buy books over the Internet is an online purchase, whereas buying groceries in a grocery store is an offline purchase.

Note also, page 3 lines 19-24, which states that:

> The disadvantage of generating advertisements based on online activity resides in the fact that a consumer's actions on the Internet (which are known to advertisers because of the cookie sent to the consumer's computer) may not be strongly related to the consumer's preferences in the offline world. Thus, a

consumer's activity on the Internet, including online purchases and access to various Web sites, may not reflect what the consumer will buy at a shopping mall or supermarket.

III. Definitions and Claim Construction

It is well known in the relevant arts that digital computer systems store data in data structures; that data structures have associated therewith field names, which are additional data assigning meaning to the data; and that code can transform the data in the data structures to either additional digital instructions or information understandable by human beings. Thus, understand reference herein below to "targeted advertisement" to refer to a related data structure, including associations between data fields, and ultimate conversion to information understandable by a human being.

By common definition, "advertisement" means "a public announcement in a newspaper or on the radio, television, or Internet advertising something such as a product for sale or an event," as for example provided by http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861583853.[1]

By common definition, "advertise" means "to publicize the qualities of a product, service, business, or event in order to encourage people to buy or use it," for example as indicated at http://encarta.msn.com/dictionary_/advertise.html.[2]

The most suitable common definition of targeted is "aim something: to aim something at or direct something toward a person, group, or thing," as for example provided by http://encarta.msn.com/dictionary_/target.html.[3]

Thus, a general definition of "targeted advertisement" synthesized from the foregoing

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[1] Attachment 1 is a copy of the definition of "advertisement" as defined by the Encarta OnLine Dictionary.

[2] Attachment 2 is a copy of the definition of "advertise" as defined by the Encarta OnLine Dictionary.

[3] Attachment 3 is a copy of the definition of "target" as defined by the Encarta OnLine Dictionary.

definitions of "targeted" and "advertisement" is an announcement in a media encouraging purchase or use of something, limited to being aimed at a specific person or group. This application contains disclosures consistent with the foregoing. This application defines targeted advertisement and its generation by expression at several places. At page 3 lines 14-18 of the specification, the Background Section defines targeted advertisement, stating that:

> The targeted advertisement can be implemented in several manners. For example, the advertiser can generate *Internet banners that contain targeted ads and are visible to the consumer when the consumer accesses the advertiser's server, and/or the advertiser can automatically generate e-mail messages and send them to the consumer if the advertiser has the consumer's e-mail address.* [Emphasis supplied.]

At page 4 lines 12-20 of the specification, the Summary of the Invention section defines the process of generating targeted advertising, stating that:

> These and other objects are achieved according to the present invention by providing a novel method, system, and computer program for delivering a targeted advertisement. *The targeted advertisement is selected based on a demonstrated purchase behavior of the consumer including an actual, monitored, or observed offline purchase history associated with the consumer.* The targeted advertisement is then electronically delivered to *a computer associated with the consumer.* Thus, with the present invention it is unnecessary to make inferences about the consumer's offline purchase behavior in selecting the targeted advertisement because the targeted advertisement has been selected based on the observed offline purchase history of the consumer. [Emphasis supplied.]

From the foregoing, it is clear that "targeted" refers to sending a certain advertisement to only a specified consumer. That is clear from the fact that the specification describes

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determining what to send based upon the purchase history of the consumer, and purchase histories vary person to person.

At page 10 lines 17-25 of the specification, the Detailed Description section defines targeted advertisements, stating that:

> The advertiser's server 18 may be a Web server programmed to send and receive registration information to and from a remote computer such as the first computer 10. The advertiser's server 18 may also be programmed to exchange information with the registration server 14, to associate a remote computer with one or more registered consumers, and to deliver targeted advertisements over the Internet to remote computers such as the first and second computers 10, 12. ***Different types of targeted advertisements, include Internet banners, real time moving videos, video information, animation information, audio information, online interstitial advertisements, electronic mailings (e-mails), interactive television advertisements, and any other type of message, recording, and/or display.*** [Emphasis supplied.]

The foregoing passage clearly conveys that what this specification means by advertisement is limited to information to be presented to the consumer, since that is what all of the foregoing highlighted examples have in common.

Thus, specification limits the meaning of "targeted advertising" from the synthesis of common meanings (an announcement in a media encouraging purchase or use of something, limited to being aimed at a specific person or group) to an announcement in a media to a single person encouraging purchase or use of something.)

At page 13 lines 8-19 of the specification, the Detailed Description section provides an example of a data structure used to "target" as defined in claim 1, that is, to determine whether and what to communicate to the person, stating that:

> FIG. 4(a) is an exemplary targeted ad profile 446 for storing information

relating to a consumer's purchase behavior classification. *The targeted ad profile 446 may be a data structure that includes a record having a field 448 for identifying the consumer.* As shown, the field 448 stores the cookie number associated with the consumer. The targeted ad profile 446 may include additional fields for storing the consumer's purchase behavior classification with regard to one or more purchase behavior criterion. ***The targeted ad profile 446 includes three fields, 449a, 449b, and 449c, for three purchase behavior classifications: Brand Z loyalty, Heavy Snacker, and Healthy Household, respectively.*** Each purchase behavior classification may be given any score (e.g., an integer), a describer (e.g., "Brand Z loyalist" or "Heavy Brand Z User"), flag ("1" or "0"), or rank (e.g., "50th out of 50,000) that the consumer has received based on selected purchase behavior criteria which are discussed below with reference to FIG. 8. [Emphasis supplied.]

IV.   **The Rejection of Claim 1 Under 35 USC 103(a) as Being Obvious Over Biorge in View of Stein and Herz is Improper and Should be Withdrawn**

In support of the 35 USC 103(a) rejection of claim 1 over Biorge in view of Stein and Herz, the examiner stated that:

5. Biorge et al teaches a method for delivering *incentive credits*, which reads on targeted advertising, comprising: receiving from a first computer (*the portable device*) a first identifier (*encrypted signals*) identifying the first computer, and associated with an observed offline purchase history of a consumer, including purchase information collected when the purchase transpired, and selecting and electronically delivering the credits/targeted advertising to the consumer at the first computer in response to receiving the first identifier (col. 5 lines 2-3 and 23-29). The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer.

6. Biorge et al. also teaches that some offline purchases, which reads on said offline purchase, are not transacted with the first computer. A "purchase" is

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an exchange for money or its equivalent (Merriam-Webster's Collegiate Dictionary). The first computer is used to transact an offline purchase only when credits are available (on the first computer) and used to pay at least part of the purchase price. The reference teaches (col. 5 lines 29-33) that presently accrued credits are not applicable to present purchases. Hence, when the only credits available are presently accrued credits, the first computer is not used to transact the purchase.

7. Biorge et al. does not teach that the first identifier is associated by a purchase behavior classification with the observed purchase history of a consumer. Stein et al. teaches that the first identifier (user code, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer. Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biorge et al.

8. Biorge et al. does not teach that said selecting is made without providing to an advertiser said purchase history. Because Herz et al. teaches (col. 5 lines 34-43) that there is need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history. [Office action mailed June 6, 2005 page 2 line 26 to page 3 line 20; emphasis supplied in the original.]

The applicant believes that the examiner's rejection of claim 1 -- that Biorge in view of Stein and Herz discloses the limitations of claim 1 -- are improper for the following reasons.

a. **The Examiner's Rejection of Claim 1 is Improper because the Examiner's Assertion that Biorge Discloses Determining a Targeted Advertisement Based upon the Consumer's Offline Purchase History is Incorrect**

In support of the rejection of claim 1, the examiner stated that:

5. **Biorge et al teaches** a method for delivering *incentive credits*, **which reads on targeted advertising**, comprising: receiving from a first computer (*the portable device*) a first identifier (*encrypted signals*) identifying the first computer, and associated with an observed offline purchase history of a consumer, including purchase information collected when the purchase transpired, and selecting and electronically delivering the credits/targeted advertising to the consumer at the first computer in response to receiving the first identifier (col. 5 lines 2-3 and 23-29). **The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer.** [Office action mailed June 6, 2005 page 2 lines 26-33; emphasis supplied.]

In response, the applicant submits that the examiner's conclusion that Biorge's "method for delivering incentive credits" teaches the claimed method of providing targeted advertising is improper. Furthermore, the examiner provides no citation to Biorge for that conclusion.

In that regard, Biorge discloses a system in which consumers earn credits for purchasing items specified by a sponsor as providing a credit upon purchase. Biorge does not disclose that the items for which credits are available depend upon the particular consumer's purchase history. Biorge does not disclose that the items for which credits are available depend in any way upon what that consumer had previously purchased. Instead, Biorge discloses that a consumer receives a credit if the consumer's current purchase order contains a item for which a sponsor provides a credit. Thus, Biorge does not disclose <u>selecting anything based at least in part upon a consumer's purchase history</u>. Biorge's system does not target as claimed because Biorge's system does not decide to provide to a consumer an advertisement based at least in part upon the consumer's purchase history.

In contrast, claim 1 recites "A method for delivering a targeted advertisement, comprising: ... <u>selecting</u> ...[a] targeted advertisement ... based on said purchase behavior classification [associated with an observed offline purchase history of the consumer]".

The examiner concludes that "The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer." In support of that

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conclusion, the examiner corresponds Biorge's portable device with the claimed "first computer." There is no reasoning, and no association of claimed limitations following this conclusion.

Apparently, the examiner intends for that assertion to imply that Biorge discloses claim 1's "selecting and electronically delivering that targeted advertisement to the consumer at the first computer based upon said purchase behavior classification" wherein claim 1 defined that the "purchase behavior classification" is based upon "an observed ... purchase history". However, all the examiner asserts is that the credits stored in the portable device are "associated with" the consumer's purchase history.

The examiner does not assert that Biorge discloses selecting anything "based on" the consumer's "purchase behavior classification." In fact, Biorgde does not disclose selecting a credit based on a consumer's purchase history.

Thus, Biorge does not disclose the limitations defined by claim 1's recitation "selecting ... the targeted advertisement ... based on said purchase behavior classification ...."

What Biorge discloses is the data storage of accounting information, a credit, based upon a current purchase by a consumer, in the consumer's portable electronic device. Biorge's preferred embodiment of that device is a smart card. Appellant's understanding of a smart card is that it does not have a display or other structure to convey information in human understandable form. Therefore, the smart card embodiment, at least, cannot display the card's stored credit to the consumer. Accordingly, Biorge does not disclose the concept of its portable device conveying credit information to the consumer.

In contrast, claim 1 recites "a method for delivering a targeted advertisement . . . to the consumer", emphasis added. Since Biorge's credit information is not displayable on Biorge's smart card, Biorge's delivering information to Biorge's smart card does not meet the limitation of claim 1.

b.   **The Examiner's Rejection of Claim 1 is Improper because there is no Motivation to Combine Biorge and Stein to Include Classification Information Which is Irrelevant to Biorge's Purpose**

In support of the rejection of claim 1, the examiner stated that:

7. <u>Biorge et al. does not teach</u> that the first identifier is <u>associated by a purchase behavior classification</u> with the observed purchase history of a consumer. <u>Stein et al. teaches</u> that the first identifier (user code, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer. <u>Because</u> classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biorge et al. [Office action mailed June 6, 2005 page 3 lines 10 to 15; emphasis supplied in the original.]

The examiner relies upon Stein to suggest modifying Biorge to "associate a purchase behavior classification with the observed purchase history of a consumer", relying upon Stein's disclosure at column 2 lines 65-66. The applicant submits that the examiner intended to rely upon Stein column 2 line 66 to column 3 line 8, wherein Stein discloses classifying use information based upon use of at least one product into classified information. Stein column 2 line 66 to column 3 line 8 states that:

A user code is provided to the prospective user. The user code is entered into a data processing means. The user code is correlated with the user information and the use information. The user information and the use information is classified based on use of the at least one product, into classified information. At least one class of information is identified as potentially relevant to future purchases. Product picks are identified and delivered based on the classified information and the user information, responsive to an inquiry on behalf of the user.

However, the purpose of Biorge is unrelated to classification; it relates only to credit information. Stein teaches classifying a user's use information to select product picks for the users. Stein provides no motivation to modify Biorge to somehow include generating

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classification information because classification information is irrelevant to Biorge's purpose of accounting for credit. Moreover, the examiner has provided no reasoning explaining (1) how Biorge's credit information in Biorge's hand-held device could be classified or (2) a motivation in the prior art suggesting why the credit information in Biorge's hand-held device should be classified. Therefore, there is no motivation to modify Biorge's hand-held device based upon Stein.

c. **The Examiner's Rejection of Claim 1 is Improper because there is no Motivation to Combine Biorge and Herz**

In support of the rejection of claim 1, the examiner stated that:

> 8. <u>Biorge et al. does not teach</u> that said selecting is made <u>without providing to an advertiser said purchase history</u>. <u>Because Herz et al. teaches</u> (col. 5 lines 34-43) that there is need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history. [Office action mailed June 6, 2005 page 3 lines 16 to 20; emphasis supplied in the original.]

In response, the applicant submits that it would not have been obvious to modify Biorge in view of Herz in the manner asserted by the examiner. The examiner does not specify a motivation to modify Biorge in view of Herz, but simply alleges that it would have been obvious "to make said selecting without providing to an advertiser said purchase history."

Biorge is a system directed to allocating and redeeming incentive credits between a portable device and a base device. See the abstract. Biorge does not disclose or suggest categorizing a consumer based upon product selections.

In contrast, Herz is directed to delivering product offers to a customer similar to the customer's prior product selections. See the abstract.

The purposes for Biorge's and Herz's process are unrelated. Therefore, they provide no

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motivation to modify one in view of the other. Moreover, even if proper, modification of Biorge based upon Herz in the manner asserted by the examiner does not overcome the deficiency of the examiner's proposed modification of Biorge in view of Stein. Therefore, the rejection of claim 1 is improper and should be withdrawn.

V. **The Rejections of Claims 55, 62-69, 72, 86, and 87, as Amended, Under 35 USC 102 as Being Anticipated by Stein are Improper and Should be Withdrawn**

a. **The Rejections of Claims 55, 86, and 87**

In support of the 35 USC 102(e) rejections of claims 55, 86, and 87 the examiner stated that:

10. <u>Stein et al. teaches</u> (independent claims 55, 86 and 87) a computer network implemented method and system for delivering targeted advertisements, the method comprising: collecting a first consumer/customer/*user* offline purchase history and identification (col. 2 lines 42-43 and 65-66); storing said consumer/customer/*user* information (col. 4 lines 14-19); (inherently) receiving from *kiosk* 5 its network address, which reads on a "consumer computer first identifier" (para.11 below), sending said kiosk network address with the *user code*/first consumer identification to the *coupon controller* 9, which reads on associating said first identifier/kiosk network address with said first consumer identification /*user code*, and determining a targeted advertisement (*targeted promotions*, col. 1 lines 10-12) for said first consumer based at least in part on said offline purchase history associated with said first consumer identification/*user code* with said identifier/*kiosk* 5 its network address (col. 6 lines 28-51); and delivering said determined targeted advertisement to said first consumer (col. 6 lines 55-57).

11. <u>Stein et al. does not explicitly teach</u> that <u>*kiosk* 5 has a network address</u>. However, under the principles of inherency (MPEP 2112.02), since the reference invention necessarily performs the method claimed, the method claimed

is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Stein et al. teach a plurality of *kiosks* **5** and other network elements in communication with *coupon controller* **9** (column 6 lines 28-45 and Fig. 3). *Coupon controller* **9** could return the coupons/promotions to the correct *kiosk* **5** only if each such network element had its own network address. [Office action mailed June 6, 2005 page 3 line 23 to page 4 line 12; emphasis supplied in original.]

In response, the applicant submits that Stein does not anticipate amended claims 55, 86, and 87. Claims 55, 86, and 87 are amended to specify the consumer's use of a point of sale terminal at which the consumer's purchase data is obtained and the consumer's use of a home or work computer, over which the consumer receives advertisements targeted based upon the consumer's purchase data. Specifically, Stein does not disclose the limitations of the following claim recitations: "collecting, during an offline purchase transaction of a first consumer at a point of sale terminal in a retail store, a first consumer offline purchase history data and a first customer identification for said first consumer", "delivering said determined targeted advertisement to said first consumer via said consumer computer", "wherein said consumer computer is at least one of a computer at said first consumer's home and a computer at said first consumer's office", and "wherein said consumer computer is not at said point of sale terminal." Therefore, the rejections of claims 55, 86, and 87 are improper and should be withdrawn.

b.   **The Rejections of Claims 63-67**

With respect to the rejections of claims 63-67, the examiner stated that:

Stein et al. also teaches at the citations given above claims 56, 63 (where the *kiosk* **5** network address reads on "a value corresponding to a cookie"), 64 (where *coupon controller* **9** reads on an advertiser's server) and 65-67. [Office action mailed June 6, 2005 page 4 lines 13-15; emphasis supplied in the original.]

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In reply, the applicant submits that for the same reasons the rejection of claim 55 is improper, the rejections of claims 63-67 are improper.

1. Claim 63

With respect to claim 63, a network address is not equivalent to a cookie. A cookie is a block of data or state object that a Web server stores on a client system. See specification page 2 lines 26-28. A network address is the network portion of an IP address. Thus, even if the kiosk does inherently have a network address, that network address is not a cookie as defined by claim 63.

2. Claim 64

With respect to claim 64, the applicants submit that the coupon controller defined in Stein does not read on an advertiser's server as disclosed in the subject application. The subject application defines an advertiser's server as a device that sends a cookie to a client computer system. When the client computer system accesses certain Web sites, the client system automatically transmits a copy of the cookie that the advertiser's server can use to identify the client system and send customized content. Page 2 line 23 through page 3 line 3.

In contrast, Stein discloses that the user must input a user code in order for the coupon controller to be able to base coupon selections on the individual user. See, for example, Stein column 6 lines 46-51, which states that:

> The kiosk 5 will begin the process when the user code is entered. As with the check-out terminals, the user code can be entered via the scanable card 19, or entered manually. The entry of the user code will permit the coupon controller 9 to correlate the user code to the stored user information, and thus to base selections on the individual user.

Since the coupon controller in Stein does not send a cookie to a client computer system, it is not an advertiser's server, as defined in the subject application. Moreover, Stein's computer

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controller is not able to identify the consumer (without the consumer entering a user code) in order to send customized content, coupon controller does not read on an advertiser's server. For these additional reasons, the rejection of claim 64 is improper and should be withdrawn.

3.   Claim 65

Furthermore, the examiner has not presented a prima facie case for the rejection of claim 65; there is no showing of the association table defined by claim 65. For this additional reason, the rejection of claim 65 is improper and should be withdrawn.

c.   The Rejections of Claims 62, 68, 72, and 69

With respect to the rejections of claims 62, 68, 72, and 69 the examiner stated that:

> Stein et al. also teaches claim 62 (col. 5 line 59), 68 and 72 (where *host system* 13, jointly with *coupon controller* 9, reads on said analytical computer because it provides *rules* for *predicting purchases*, col. 4 line 13 and col. 5 lines 9-12), 69 (col. 4 line 14). [Office action mailed June 6, 2005 page 4 lines 16-18; emphasis supplied in the original.]

In reply, the applicant submits that for the same reasons the rejection of claim 55 was improper, the rejections of claims 62, 68, 72, and 69 are improper.

VI.   The Rejection of Claim 70 Under 35 USC 103(a) as Obvious Over Stein in View of Willman is Improper and Should be Withdrawn

With respect to claim 70, the examiner stated that:

> Claim 70 is rejected under 35 USC 103(a) as obvious over Stein et al. in view of Willman et al. (US 20030195806A1). Stein et al. does not teach analysis of consumer data and selection of promotions in real time. Willman et al. teaches analysis of consumer data and selection of promotions in real time (para. [0008-

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0009]). Because <u>Willman et al. teaches</u> that this eliminates many problems in coupon distribution (para. [0004-0007]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Willman et al. to those of Stein et al. [Office action mailed June 6, 2005 page 4 lines 19-25; emphasis supplied in the original.]

In reply, the applicant submits that the rejection of claim 70 is improper because US PGP 20030195806 to Willman is not prima facie prior art. Willman has a filing date of April 24, 2003 and claims to be a continuation of an application filed November 3, 1999. This application has a declaration executed March 24, 1999 and is a continuation of an application filed January 7, 1999.

VII.   **The Rejections of Claims 57-61, 71, and 73-85 Under 35 USC 103(a) as Obvious Over Stein are Improper and Should be Withdrawn**

With respect to claims 57-61, 71, and 73-85 the examiner stated that:

<u>Stein et al. does not teach</u> the purchase history data limitations of claims 57-61, <u>IVR</u> (claim 71) or registration at a <u>web page</u> (claims 73-85). Official notice is taken (MPEP 2144.03 that all of the purchase history data was commonly acquired and are of clear use to a retailer for product promotion, and also that IVR communication and web page registration were common at the time of the invention. It is obvious to follow common practices. [Office action mailed June 6, 2005 page 4 lines 27-31; emphasis supplied in the original.]

In reply, the applicant submits that for the same reasons the rejection of claim 55 is improper, the rejections of claims 57-61, 71, and 73-85 are improper.

As per claims 57-61, the examiner takes official notice that it is allegedly old and well known for offers to teach the purchase history limitations of claims 57-61. However, the examiner's official notice does not address the purchase history limitations of claims 57-61. Specifically, claims 57-61 define attributes of said first consumer offline purchase history.

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Neither Stein nor the examiner's official notice suggest modifying Stein to include the limitations of "said first consumer offline purchase history," as defined by claims 57-61. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejections of claims 57-61 are improper and should be withdrawn.

As per claim 71, the examiner takes official notice that it is allegedly old and well known for offers to teach the purchase history limitations of claim 71. However, the examiner's official notice does not address the limitations of claim 71. Specifically, claim 71 defines exchanging information between [an] IVR provider and said analytical computer system; providing an IVR message to said first consumer from said IVR provider. Neither Stein nor the examiner's official notice suggest modifying Stein to include "exchanging information between [an] IVR provider and said analytical computer system; providing an IVR message to said first consumer from said IVR provider," as defined by claim 71. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejection of claim 71 is improper and should be withdrawn.

As per claims 75-83, the examiner takes official notice that it is allegedly old and well known for offers to teach the limitations related to claims 75-83 regarding registration at a web page.

However, the examiner's official notice does not address the limitations of claims 75-83. Neither Stein nor the examiner's official notice suggest modifying Stein to include the limitations related to claims 75-83 regarding registration at a web page. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejections of claims 75-83 are improper and should be withdrawn.

VIII.   **The Examiner's Assertions that Claimed Terms (online/offline; retail store; association table; analytical computer system; advertiser's server; and registration server) are not Expressly Defined in the Specification are Incorrect**

The examiner makes two additional points at the end of the office action mailed June 6, 2005. The examiner stated that:

> 16. <u>Note on interpretation of claims terms</u> Unless a term is given a "clear

definition" in the specification (MPEP 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

     17. The instant application contains no such clear definition for <u>any</u> terms, including "online/offline", "consumer computer", retail store", association table", analytical computer system", advertiser's server" and registration server". The spec. does define online/offline in para. [0004] of published application (US 20020046105A1), but this definition is flawed by not defining grocery stores connected to a computer network. In the instant case, the examiner is required to give these terms their broadest reasonable interpretation. [Office action mailed June 6, 2005 page 5 lines 3-18; emphasis supplied in the original.]

In reply, the applicant submits that the specification contains clear definitions of the terms online/offline, consumer computer, retail store, association table, analytical computer system, advertiser's server, and registration server.

On page 1 lines 23-27, the specification defines "online/offline" as the following:

     As used herein, the term "online" refers to activity having at least one aspect that is performed over a computer network, whereas the term "offline" refers to customer activity that is generally not performed over a computer network. For example, using a computer to buy books over the Internet is an online purchase, whereas buying groceries in a grocery store is an offline

purchase.

The examiner asserts that this definition is flawed because the grocery store of the pending specification is not connected to a computer network. Office action mailed June 6, 2005 page 5 lines 15-18. That assertion is a non sequitur.

On page 9 lines 18-29, the specification defines "consumer computer" as the following:

> The first and second computers 10, 12 may be any computer that one or more consumers can access, such as home or office computers. The first and second computers 10, 12, may also be implemented as interactive television sets or other structure suitable for receiving interactive advertisements. Interactive television systems are described in U.S. Patent Nos. 4,847,700, 5,721,583, and 5,552,735. U.S. Patent Nos. 4,847,700, 5,721,583, and 5,552,735 and all references cited therein are incorporated herein by reference. The first and second computers 10, 12 may be programmed with any suitable Web browser software that permits the first and second computers 10, 12 to retrieve Web pages via the Internet 20 from remote computers or servers such as the advertiser's server 18 and/or the registration server 14. The Web browser software may also be used to transmit registration information provided by a consumer to a remote computer such as the advertiser's server 18 and the registration server 14.

On page 8 lines 21-27, the specification defines "retail store" as the following:

> The stores 2, 4, 6 may be any retail location, point of sale, or other location in which offline transactions are made by consumers. The stores 2, 4, 6 record purchase data for the consumers that present their CIDs at checkout. The purchase data includes information such as the location of the purchase, the items purchased, the price of each item purchased, and CID. The purchase information can be stored electronically in a general purpose computer in each of the stores 2,

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4, 6 and sent to the purchase history database 8 periodically, in real time, or at any other time when it is desirable to update the purchase history database 8.

On page 12 line 16 through page 13 line 7, the specification defines "association table" as the following:

Figure 3 illustrates an association table 40 for storing information that associates a computer with a particular consumer and master record. The association table 40 may be implemented as a data structure including a list 42 of first identifiers linked to a list 44 of second identifiers. As shown, the list 42 is a list of cookie numbers. Each cookie number corresponds to a cookie that has been sent to a computer as a result of a consumer registering online with the registration server 14 (described below with reference to Figure 7). Accordingly, each cookie number identifies a single Web browser run on a computer that was used by a consumer to register. The list 44 is a list of CIDs, each of which corresponds or is linked to the adjacent cookie number in the list 42. Each CID in the list 44 is also stored in the purchase history database 8 in a master record. Thus, the association table 40 links a Web browser (via the cookie number) with a master record (via the CID) for a consumer who used the Web browser to register online. The association table 40 may be stored in the registration server 14 or any other suitable stored device including any of the devices shown in Figure 1 (e.g., the registration server 18). As technology progresses, cookies may become associated with individuals and not directly correspond to a Web browser, and the invention includes the use of identification methods other than conventional cookies.

The association table 40 may contain additional lists and/or fields. For example, it may be desirable for the association table 40 to include a field that identifies the association table 40 if multiple association tables are generated and stored. Preferably, the association table 40 stores at least one list of identifiers

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which are also stored in the purchase history database 8 and which identify registered consumers.

On page 10 lines 7-16, the specification defines "analytical computer system" as the following:

The analytics unit 16 may be implemented using any desired structure such as a computer programmed to analyze purchase data (e.g., master records) received form the purchase history database 8. Thus, the analytics unit 16 may be programmed to receive purchase behavior criteria from a remote computer (e.g., the registration server 14 and/or the advertiser's server 18) and apply those criteria to the purchase data in the purchase history database 8 to classify consumers into one or more purchase behavior classifications. As shown, the analytics unit 16 communicates directly with the purchase history database 8, the registration server 14, and the IVR provider 29; however, the analytics unit 16 may also be connected to other remote computers (e.g., the advertiser's server 18) directly, via the Internet 20, or through any network.

On page 10 lines 17-25, the specification defines "advertiser's server" as the following:

The advertiser's server 18 may be a Web server programmed to send and receive registration information to and from a remote computer such as the first computer 10. The advertiser's server 18 may also be programmed to exchange information with the registration server 14, to associate a remote computer with one or more registered consumers, and to deliver targeted advertisements over the Internet to remote computers such as the first and second computers 10, 12. Different types of targeted advertisements, include Internet banners, real time moving videos, video information, animation information, audio information, online interstitial advertisements, electronic mailings (e-mails), interactive

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television advertisements, and any other type of message, recording, and/or display.

On page 10 lines 1-6, the specification defines "registration server" as the following:

The registration server 14 is a Web server programmed to receive, store, and/or transmit various type of information, including registration information, purchase behavior information, and information for identifying consumers, although the registration server may also be implemented using any type of computer. The registration server 14 may additionally be programmed to generate records that link various types of registration information received from consumers and the advertiser's server 18.

Furthermore, figure 1 shows the relationship between consumer computer, retail store, analytical computer system, advertiser's server, and registration server. Figure 3 shows an association table.
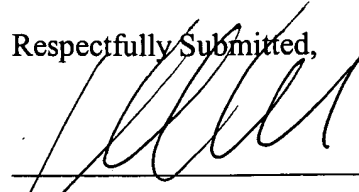
Hence, the examiner is incorrect in his assertion that the instant application contains no such clear definition for any terms, including "online/offline", "consumer computer", retail store", association table", analytical computer system", advertiser's server" and registration server."

IX.   Closure

Should the examiner have any questions, the examiner is urged to contact the undersigned at 703-415-0012.

Respectfully Submitted,

_11/18/2005_

DATE

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BTM/DHS

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Neifeld Reference: OBSP5GARD-USC2

List of Attachments

Attachment 1 is a copy of the definition of "advertisement" as defined by the Encarta OnLine Dictionary.

Attachment 2 is a copy of the definition of "advertise" as defined by the Encarta OnLine Dictionary.

Attachment 3 is a copy of the definition of "target" as defined by the Encarta OnLine Dictionary.